

## **Remarks**

On page 3 of the Office Action the Examiner states: "...the elected embodiment is not allowable". In the telephone discussion of 28 July 2009 the Examiner clarified that the rejection of the elected species is based upon the 112 enablement rejection.

The specification has been amended as suggested by the Examiner. The "claim" designations have been deleted. No new matter has been added. In addition, as suggested by the Examiner, claim 7 has been cancelled and the limitation has been incorporated into claim 1.

### **Rejections under 35 USC 112**

Claims 1-6 and 8-14 stand rejected under 35 USC 112. Applicants respectfully traverse this rejection. The claims are fully enabled. The claims are directed to a *process* for the preparation of a compound of formula I. The rejection has not demonstrated how the specific elected species is not enabled. For example, the Examiner has not alleged that the specific elected species is a compound of formula II which has a pKa value > 3. Additionally, the Examiner has not indicated or even alleged that a compound of Formula II having an X group in accordance with the elected species has a pKa value > 3.

Furthermore, applicants' claims are process claims which are inherently functional. In other words, the literal scope of the process claims encompass only those embodiments that achieve the specified function. See, e.g., *In re Angstadt*, 190 USPQ 214 (CCPA 1976) and *Dinn-Nguyen et al.*, 181 USPQ 46 (CCPA 1974). The Examiner argues that the claimed process will not work with compounds formula II having a pKa value > 3. However, the literal language of claim 1 is directed to processes which achieve the recited results. The literal language of the claim recites that the compound of formula I is obtained, and thus the literal language does not include embodiments which do not achieve this result.

In any event, in the interest of furthering prosecution claim 1 has been amended to incorporate the limitations of claim 7.

Thus, it is respectfully requested that the rejection under 35 USC 112 be withdrawn.

### Restriction/Election

Reconsideration of the Restriction Requirement is respectfully requested.

Applicants respectfully submit that the claims of Group II and Group III, which are drawn to compounds of formula III and a process for preparing formula III, should be maintained and examined with the claims of elected Group I in a single application. Groups I-III relate to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product. As such, according to the Administrative Instructions Under the PCT, ANNEX B(e)(i) unity of invention under Rule 13.2 exists.

Accordingly, it is respectfully submitted that unity of invention exists as to groups I, II and III, and reconsideration of the Requirement Restriction is respectfully requested.

Furthermore, it is respectfully submitted that the scope of examination should have been and should be extended beyond the elected species. On page 2 of the Office Action, last sentence, the Examiner alleges: "As the rejected species has been found not allowable, the Markush-type claims have been rejected and claims to the nonelected invention held withdrawn from further consideration."

This is a conclusory statement. As noted above, the Examiner has not demonstrated that the specific elected compound is not enabled. Furthermore, MPEP 803.02 states"

"Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be **anticipated or rendered obvious by prior art**, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. "

However, no prior art rejections have been made. Thus, the elected species has not been found to be anticipated or rendered obvious by the prior art. Applicants respectfully request that examination of the Markush-type claim be extended.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,  
/Brion P. Heaney/

---

Brion P. Heaney, Reg. No. 32,542  
Attorney for Applicant(s)

/Jennifer Branigan/

---

Jennifer Branigan, Reg. No. 40,921  
Agent for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-3121  
Date: **30 July 2009**